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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,830	11/09/2001	John Zimmerman	701483 (PHIL06-01483)	3045

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EXAMINER

HOSSAIN, FARZANA E

ART UNIT PAPER NUMBER

2623

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/990,830

Applicant(s)

ZIMMERMAN ET AL.

Examiner

Farzana E. Hossain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07-06-06 has been entered.

### ***Response to Amendment***

2. This action is in response to communications filed 07-06-06. Claims 1-42 are original.

3. The declaration filed on 06-01-06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Schaefer reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Schaefer reference to either a constructive reduction to practice or an actual reduction to practice. The declaration fails to provide continuous diligence from March 2, 2001 to November 9, 2001 .

4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Schaefer reference. While conception is the mental part

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of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The declaration fails to provide conception for independent Claims 1, 14, 27, and 40, specifically selectively generating a notification signal as a function of said detected special event content and a subscriber profile. Therefore, the declaration does not provide conception for the dependent claims 2-13, 15-26, 28-33, 35, 36, 41-42, specifically including claims 2-7, 9, 15-20, 22, 41-42. The lack of conception for the dependent claims include (but is not limited to) a measurable characteristic of a subscriber, mathematical representation of a notification preference and communication of a message, operation of an appliance, and a device operating in active or standby modes.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 40 defines a notification signal with descriptive material. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, a signal embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within

one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 8-17, 21-30, 34-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Schaefer et al (US 2002/0124252 and hereafter referred to as "Schaefer").

Regarding Claims 1, 14, 27, and 40, Schaefer discloses an appliance comprising a receiver capable of receiving broadcast content streams (Figures 1-3, 152); and a monitoring system or set top box (STB) capable of identifying special event content within the received broadcast content streams (Page 5, paragraph 0045), each of the received broadcast streams having detectable content attributes or triggers (Page 5, paragraphs 0044-0045), the monitoring system operable to sense a content change within at least of the received streams as a function detectable content attributes (Page 5, paragraphs 0044-0045), detect the special event content broadcast within the least of on the received steams as a function sensed content change (Page 5, paragraphs

0044-0046) and selectively generate a notification signal a function of detected special event and a subscriber profile (Page 5, paragraphs 0043-0047).

Regarding Claim 2, 15, and 28, Schaefer discloses all the limitations of Claims 1, 14, and 27 respectively. Schaefer discloses that the subscriber profile is stored in memory (Page 7, paragraph 0062, Page 4, paragraph 0038) and comprises at least one record that maintains at least one measurable characteristic of an associated subscriber or specific program, time of day, type of information alerts (Figure 5, Page 5, paragraphs 0046-0047).

Regarding Claim 3, 16, and 29, Schaefer discloses all the limitations of Claims 2, 15, and 28 respectively. Schaefer discloses the stored subscriber profile is always compared with the alert in order to display a notification signal (Figure 7, 706). It is necessarily included that a user profile is initially set as a default profile in order to compare alerts to user profile in order to determine if the notification symbol should be generated.

Regarding Claim 4, 17, and 30, Schaefer discloses all the limitations of Claims 2, 15, and 28 respectively. Schaefer discloses that the monitoring system is further operable to update the stored subscriber profile (Page 5, paragraph 0047-0049).

Regarding Claim 8 and 21, Schaefer discloses all the limitations of Claims 1 and 14 respectively. Schaefer discloses that the monitoring system comprises to comprising a content monitoring controller or processor (Page 5, paragraph 0045) that is operable to receive the plurality of broadcast stream from at least on receiver (Figures 1-3, 152), monitor the plurality of received streams (Page 5, paragraphs 0044-0046),

sense changes in the plurality of received broadcast content streams as a function of detectable content attributes (Page 5, paragraph 0044-0049).

Regarding Claim 9 and 22, Schaefer discloses all the limitations of Claims 1 and 14 respectively. Schaefer disclose that the identifying special content within a plurality of broadcast content streams comprising a special event detecting controller or processor (Page 5, paragraph 0045) that identifies special event content as a function of the sensed content change (Page 5, paragraphs 0044-0046), the content detecting controller operable to direct at least one of a plurality communication units including STB, cellular telephone, pager (Page 5, paragraphs 0044, 0050) to communicate a message to an associated subscriber (Figure 6).

Regarding Claim 10, 23, and 34, Schaefer discloses all the limitations of Claims 9, 21, and 27 respectively. Schaefer discloses that the monitoring system is further operable to identify the scheduled broadcast content or regular programming and unscheduled broadcast content or emergency alert that preempts scheduled broadcast content by displaying the emergency warning (Page 5, paragraph 0046).

Regarding Claim 11, 24, and 37, Schaefer discloses all the limitations of Claims 1, 14, and 27 respectively. Schaeffer discloses that a trigger with information alert can appear (Page 7, paragraphs 0067-0070). Schaefer discloses that the monitoring system is further operable to monitor video content (Page 6, paragraphs 0068-0069) within the plurality of broadcast streams.

Regarding Claim 12, 25, and 38, Schaefer discloses all the limitations of Claims 11, 24, and 37 respectively. Schaeffer discloses that the monitoring system detects the

special event content broadcast within the at least one of broadcast content stream as a function of video content (Page 7, paragraph 0068-0069) within the plurality of broadcast streams.

Regarding Claim 13, 26, and 39, Schaefer discloses all the limitations of Claims 11, 24, and 37 respectively. Schaeffer discloses that content attributes filter the triggers in the VBI or text of the video/television signal to transmit information alerts to the viewer (Page 7, paragraphs 0068-0070), which reads on monitoring the transcript of the video content and the monitoring system detects the special event broadcast within the broadcast streams as a function of the transcript.

Regarding Claim 35, Schaefer discloses all the limitations of Claim 27. Schaefer disclose that the subscriber profile is actively associated (Page 5, paragraphs 0046-0048).

Regarding Claim 36, Schaefer discloses all the limitations of Claim 27. Schaefer disclose that the subscriber profile is passively associated (Page 5, paragraph 0049).

Regarding Claim 41, Schaefer discloses all the limitations of Claim 40. Schaefer discloses that the selectively generated notification signal directs operation of an appliance (Figure 6).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5-7, 18-20, 31-33, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer in view of Yen et al (US 6,668,278 and hereafter referred to as "Yen").

Regarding Claim 5, 18, and 31, Schaefer discloses all the limitations of Claims 2, 15, and 28 respectively. Schaeffer is silent on the mathematical representation. Yen discloses that the subscriber profile provides a mathematical representation of a notification preference of an associated subscriber (Column 9, lines 53-67, Column 10, lines 16-21, Column 11, lines 58-67, Column 12, lines 1-15). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Schaefer to include that the subscriber profile provides a mathematical representation of a notification preference of an associated subscriber (Column 9, lines 53-67, Column 10, lines 16-21, Column 11, lines 58-67, Column 12, lines 1-15) as taught by Yen in order to present information to a recipient from filtering information based on the behavior of the recipient (Column 1, lines 63-67, Column 2, lines 1-4, lines 42-52) as disclosed by Yen.

Regarding Claim 6, 19, and 32, Schaefer discloses all the limitations of Claims 5, 18, and 31 respectively. Schaefer is silent on the mathematical representation. Yen discloses that the subscriber profile is generated by the monitoring the system at definition and includes a default notification preference that is modifiable by the associated subscriber or a value can be assigned in response to an absence of

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detectable content or tag, which is in this case is a default value that the recipient can change (Column 9, lines 53-67, Column 10, lines 16-21).

Regarding Claim 7, 20, and 33, Schaefer discloses all the limitations of Claims 5, 18, and 33 respectively. Schaeffer is silent on the mathematical representation. Yen discloses that the as a function of the mathematical representation, the notification signal selectively directing the plurality of the set top box to communicate a message to the associated subscriber (Column 11, lines 12-19).

Regarding Claim 42, Schaefer discloses all the limitations of Claim 41. Schaefer is silent on the active and standby mode. Yen discloses that the appliance is capable of operation in an active mode and a standby mode and when the appliance is operating in the standby mode, the signal directs the associated appliance to switch from the standby mode to the active mode (Column 13, lines 38-58). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Schaefer to include the operation in an active mode and a standby mode and when the appliance is operating in the standby mode, the signal directs the associated appliance to switch from the standby mode to the active mode (Column 13, lines 38-58) as taught by Yen in order to present information to a recipient from filtering information based on the behavior of the recipient regardless of activity of the machine (Column 2, lines 61-67, Column 3, lines 1-7) as disclosed by Yen.


***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH  
August 18, 2006

  
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